

### **REMARKS/ARGUMENTS**

Claims 1-9 and 11-22 are pending in the application. In the Office Action of May 31, 2006, claim 11 was rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Additionally, claims 1, 4-12, and 14-19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Evans (U.S. Patent No. 5,924,074). Claims 2-3 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Denny (U.S. Patent No. 6,687,676). Furthermore, claims 13, and 21-22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Mayaud (U.S. Patent No. 5,845,255). Finally, claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Evans in view of Lee ("Fujitsu Pen Computer Will Ship with Windows 95").

As addressed in the Interview Summary of July 11, 2006, a telephonic interview was conducted between the Undersigned and the Examiner on July 6, 2006. During that interview the above-listed amendments were discussed. In particular, the Undersigned and the Examiner worked jointly to craft language embodied as the amendment to claim 1, which was specifically designed to address the concerns set forth by the Examiner in Section (A) the "Response to Arguments" section of the Office Action of May 31, 2006. In summary, the amendments are presented to clarify the positions articulated in the previous Amendments. Thus, for the reasons that will be addressed below, Applicant believes that the claims are patentably distinct from the art of record. Before addressing those distinctions in detail, Applicant also notes that, as discussed with the Examiner, various amendments to the claims have been presented to improve readability.

#### **Rejections under §102(b)**

Applicant believes, that in light of the above-listed amendments, the conditional step of enabling access by a physician to additional support features only after a particular diagnosis code has been entered distinguishes the claimed invention from the prior art of Evans and Denny for the reasons provided in the previous Amendments. In particular, the Examiner noted that Evans, like the present invention, provides a method of inputting diagnosis codes and works at a

point of care location. Additionally, as illustrated in Fig. 18 of Evans, it seems that the disclosed system provides access to an optional references database 104 that assists the healthcare provider in prescribing medications and administering treatments. In the previous Office Actions, the Examiner has asserted that this reference database 104 of Evans constitutes "additional physician support features related to a treatment of a medical diagnosis," as is claimed in claim 1.

Nevertheless, as is apparent from Fig. 20 of Evans, access to the references database 104 is not conditional on the entry of a diagnosis code, as expressly stated in elements (A) and (C) of claim 1. That is, Evans teaches that both the diagnosis codes and the references database are simultaneously available on the same screen and freely selectable in any order desired by the physician. The physician is not required to enter a diagnosis code through the left hand side of Fig. 20 in order to unlock access information on related procedures available on the right hand side of Fig. 20.

Thus, unlike the claimed invention, the system does not use the selection of a diagnosis code to serve as a gate keeper to access the additional information. In fact, Evans, when referring to Fig. 10, states that the physician may access optional practice guidelines that allow the physician to consult resources regarding alternative treatments for various conditions, which are accessible irrespective of the selection of a diagnosis code. See col. 7, ll. 52-61. That is, Fig. 10 clearly shows that this treatment information may be obtained directly from the patient data capture box 140, which does not require the input of diagnosis codes.

This is not a trivial distinction. As discussed with the Examiner during the telephonic interview and addressed in the present application, the present invention recognizes that by using the diagnosis codes as a gatekeeper to accessing the "additional physician support features," the system is able to encourage physicians to accurately and consistently select diagnosis codes and, in turn, facilitate valuable and extractable data that can be used to enhance outcome-based medicine. However, the prior art of record, and, in particular, Evans provides strong evidence that a person of ordinary skill in the art even having access to the required components of: a database, a point of care terminal, diagnosis codes, and physician

support materials, would not recognize that the various elements could be linked to incentivize the physicians to capture diagnosis codes or the benefits of doing so.

For at least these reasons, claim 1 is patentably distinct from the art of record. Accordingly, claims 2-9 and 11- 22 are in condition for allowance at least pursuant to the chain of dependency. However, as will be addressed below, many of these claims include elements that are distinguishable over the art of record above and beyond the chain of dependency.

#### Rejections under §103(a)

As stated above, the Office Action rejected claims 2-9 and 11-22 under various combinations of Evans with Denny, Mayaud, or Lee. However, as will be shown below, the Office Action has failed to establish a *prima facie* case of obviousness and the rejections must be withdrawn.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. See MPEP §2142. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. See ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes each and every element of the claimed invention, but also provide "a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). That is, "[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP § 2143.01. "The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." *Id.* When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the

desirability, and thus the obviousness, of making the combination. See Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Therefore, the basic criteria for establishing a *prima facie* case of obviousness is as follows.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.  
MPEP §2143

As addressed above, Evans does not teach or suggest each and every element of the claims because it does not teach or suggest that access to additional support features is restricted until selection of a diagnosis code is made. Thus, with respect to the primary reference used to support the proffered rejection, the third part of the burden for establishing a *prima facie* case of obviousness has not been met.

In a manner similar to Evans, Denny teaches a system of providing a patient with patient handouts but, like Evans, the access to the additional information is not conditional on the physician providing a diagnosis code. Thus, Denny does not remedy the deficiency of Evans described above. Hence, even assuming *arguendo* that the combination of Evans and Denny is suggested or motivated and would have a reasonable expectation of success, the third part of the burden for establishing a *prima facie* case of obviousness remains unmet.

Mayaud, as noted by the Examiner, teaches a system that presents a list of treatments ordered according to their frequency of use. However, again, access to these "additional support features" is not predicated on the entry of a diagnosis code. Hence, again assuming *arguendo* that the combination of Evans and Mayaud is suggested or motivated and would have a reasonable expectation of success, the third part of the burden for establishing a *prima facie* case of obviousness remains unmet.

Therefore, even if a person of ordinary skill in the art were led to combine these references, they still would not teach or suggest each and every element of claim 1 or the additional elements of claims 2-9 and 11-22, many of which further

define the elements of claim 1. In fact, each of these references teaches away from an important insight of the present invention. That is, the present invention has recognized that by simplifying the entry of diagnosis codes and requiring their entry prior to obtaining desirable information, that physicians can be encouraged to specify exact diagnosis codes allowing sophisticated data mining and promoting outcome-based medicine, as described generally in paragraphs [0001]-[0006] and [0013] and elsewhere in the present application. To the contrary, each of the cited references teaches that diagnosis codes are only optionally presented to the physician, which implies that it is impossible or unreasonable to expect the physician to enter the diagnosis code prior to taking advantage of additional features of the inventions.

In light of these remarks and amendments, it is believed that claims 1-9 and 11-22 are now in condition for allowance and allowance is respectfully requested. Though no fee is believed due as a result of this communication, please charge any fees due to Deposit Account No. 17-0055.

Respectfully submitted,

THOMAS D. DOERR

By:   
\_\_\_\_\_  
Jack M. Cook, Reg. No. 56,098  
Attorney for Applicant  
Quarles & Brady LLP  
411 E. Wisconsin Avenue  
Milwaukee WI 53202-4497  
(414) 277-5405